



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/865,419 05/28/97 AUGER

S CLINK0002

EXAMINER

IM62/0128

JAMES C. WRAY
1493 CHAIN BRIDGE ROAD
SUITE 300
MCLEAN VA 22101

LIOTT, C

ART UNIT

PAPER NUMBER

1751

DATE MAILED:

01/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/865,419

Applicant(s)
Auger

Examiner
Caroline D. Liott

Group Art Unit
1751



☒ Responsive to communication(s) filed on Nov 12, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10, 20-23, 25, 26, and 29-36 is/are pending in the application.

Of the above, claim(s) 23, 25, 26, and 29 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10, 20-22, and 30-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1751

Applicant's Amendments filed 11/12/99 have been entered. Applicant's Remarks filed 11/12/99 have been fully considered.

Restriction Requirement

OK This application contains claims 23, 25-26 and 29 drawn to an invention nonelected with traverse in Paper No. 11. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Objections

Claim 31 is objected to because of the following informalities:

OK Two commas follow the term "thickener" in line 4 of claim 31. Appropriate correction is required.

Claim Rejections

Claims 1-10, 20-22 and 30-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 30 are indefinite because the term "metal/mineral salt" is defined so broadly that it reads on the claimed "oxygen source" and/or "peroxide." For example, zinc peroxide reads on both the claimed salts and oxygen sources, see claims 8 and 10. This causes confusion in the claims, e.g. can a single aqueous solution of zinc peroxide read on the claimed kits?

Art Unit: 1751

Similarly, the “base” of claim 31 reads on the “oxygen source” of claim 30 (e.g. sodium hydroxide). A claim is indefinite when two terms are defined so broadly that they read upon one another. Clarification is required.

Claim 1 is indefinite because the last five lines of the claim do not make sense. It is unclear how these claim limitations further define the claim. Clarification is required.

Claim 3 is indefinite with regard to the term “both preparations consisting essentially of aqueous solutions.” First, the term is grammatically incorrect. The term should be amended to recite that the preparations “consist essentially of” aqueous solutions. Second, it is unclear what the term “aqueous solutions” encompasses. Clarification is required.

Claim 21 is indefinite because the term “the process conditions of the method” lacks proper antecedent basis in the claims.

Claim 30 is indefinite for reciting that the preparations further comprise an “aqueous,” i.e. an aqueous what? Clarification is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 1751

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsushita Electric Works. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #23 mailed 7/21/99.

Matsushita Electric Works, JP 60-250,906, teaches and exemplifies a two-component “kit” for imparting a pre-determined bleached color to a wood substrate which comprises an aqueous solution consisting of a cobalt or nickel metal salt, and an aqueous solution consisting of hydrogen peroxide, see page 4, Table and paragraph 1. Matsushita Electric Works, therefore, clearly anticipates kits as claimed. Note that Matsushita’s bleaching kits do not anticipate or obviate “kits for coloring wood substrates” as claimed because bleaching is the opposite of coloring; however, bleaching does result in a “pre-determined color” as currently claimed.

Claims 3-7, 9-10 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #23 mailed 7/21/99.

Brown, U.S. Patent No. 5,173,085, teaches and exemplifies three-part compositions for dyeing hair wherein the first part comprises an aqueous solution which contains additives (e.g. a surfactant) and a metal salt (e.g. copper sulfate) in the claimed amounts, and the third part comprises a 6% aqueous solution of hydrogen peroxide, see Examples 2-4. Brown, therefore, clearly anticipates the claimed kits.

Art Unit: 1751

Claims 3-10 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Tennigkeit. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #23 mailed 7/21/99.

Tennigkeit, U.S. Patent No. 4,992,077, teaches and exemplifies two-part compositions for dyeing hair wherein the first part comprises water, additives and a metal salt (copper (II) chloride or copper sulfate) in the claimed amounts, and the second part contains hydrogen peroxide in the claimed amounts, see Examples 1a-3a and col. 5, lines 22-27. Tennigkeit, therefore, clearly anticipates kits as claimed.

Claims 1, 3-6, 9-10, 30 and 32-36 are rejected under 35 U.S.C. 102(b) as anticipated by Est. Light Ind. Min (herein referred to as Light). This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #23 mailed 7/21/99.

Light, SU 499,297 (see English language translation for all citations), teaches processes for treating leather by first treating with a solution which contains hydrogen peroxide and sodium hydroxide (oxygen sources and base) in the claimed amounts, followed by treating with a solution which contains alum (aluminum potassium sulfate) alone or in combination with chromium salts in the claimed amounts, see Example. Light, therefore, clearly anticipates kits as claimed.

Claims 3-7, 30-31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Yantai University. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #23 mailed 7/21/99.

Art Unit: 1751

Yantai University, CN 86-104,010, teaches and exemplifies two compositions which are applied stepwise to marble to impart a color to the marble, wherein the first part is a solution of silver nitrate, and the second part is a solution of water, formaldehyde and sodium hydroxide (oxygen source) as claimed, see provided CAPLUS Abstract. Yantai University, therefore, clearly anticipates kits as claimed.

Claims 2-10, 21, 30-31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Bures. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #23 mailed 7/21/99.

Bures, CS 145,495 (see provide CAPLUS Abstract for all citations) teaches and exemplifies a three step process for treating wood with three aqueous solutions wherein the first solution (A) contains the claimed manganese chloride, ferric chloride, alcohol and hydrogen peroxide, and the third solution (C) contains the claimed silver nitrate. The solutions appear to be applied at room temperature. Bures, therefore, anticipates kits and methods as claimed.

Claims 2-8, 9-10, 20-22, 30-34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Dombay. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #23 mailed 7/21/99.

Dombay, U.S. Patent No. 3,554,785, teaches and exemplifies a process for treating wood (teak) with a kit as claimed in order to obtain a color on the wood, see Example 4. Specifically, the "kit" comprises a solution A which contains the metal salt cupric sulfate in the claimed amounts, as well as an acid (hydrochloric) as claimed, see Example 4. This composition is diluted

Art Unit: 1751

with water and is first applied to the wood, followed by drying as claimed. The wood is then treated with a second aqueous solution which contains hydrogen peroxide in the claimed amounts, see Example 4 and col. 3, lines 19-25. Dombay teaches that this solution is also suitable for dilution as claimed, see col. 5, lines 56-64. The wood is then treated with a nitrocellulose lacquer (sealant) as claimed. The method takes place at room temperature.

Also note Example 5 wherein wood is treated with a first composition containing potassium permanganate in the claimed amounts, and additives as claimed, wherein the composition is diluted with water as claimed. After drying and treating with a hypochlorite composition, the wood is treated with a solution of hydrogen peroxide as claimed. Dombay, therefore, clearly anticipates wood coloring kits as claimed, and wood coloring methods as claimed.

Claims 2-8, 9-10, 20-22 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dombay. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #23 mailed 7/21/99.

Dombay is relied upon as set forth above as teaching and exemplifying wood coloring kits which comprise an aqueous solution of a metal salt, and an aqueous solution of hydrogen peroxide as claimed. Dombay teaches that the peroxide oxidant may be present in the lower claimed proportions (see col. 4, lines 35-38), but does not exemplify a kit which contains the peroxide in such proportions.

Art Unit: 1751

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a kit which comprises a first composition which contains water and a metal salt in the claimed amounts, and a second composition which contains water and hydrogen peroxide in the claimed amounts, wherein each composition is sequentially applied to wood to color the wood, because such kits fall within the scope of those as taught by Dombay.

Response to Arguments

Applicant's Amendments have overcome most of the claim objections previously of record, except for the above objection over claim 31 which remains for the reasons of record.

Applicant's Amendments have overcome some of the 35 U.S.C. 112, second paragraph rejections, the others which remain for the reasons set forth above. Also note the new grounds of rejection under 35 U.S.C. 112, second paragraph, set forth above due to Applicant's claim amendments.

Applicant's Remarks regarding the above art rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) have been fully considered, but are not deemed persuasive to overcome the rejections for the following reasons.

Regarding the above rejection over Matsushita, Applicant argues that the reference colors wood with dyes and synthetic resins, and therefore teaches away from the invention. This argument is not deemed persuasive because the Example relied upon in Matsushita *contains no dyes or synthetic resins*.

Art Unit: 1751

Regarding the above rejection over Brown, Applicant argues that Brown dyes hair, not wood. It is well settled that a mere statement of a new use for an otherwise old or mere obvious composition cannot render a claim to the composition patentable. See *In re Zierden*, 162 USPQ 102, 107. The intended use of the claimed kits is given little, if any, patentable weight. See *In re Albertson*, 141 USPQ 730 (CCPA 1964), and *In re Heck*, 114 USPQ 161 (CCPA 1957).

Applicant argues that Brown's methods comprise intermediate steps, and that Brown's peroxide bleaches rather than fixing the metal salts. The claimed kits do not exclude Brown's intermediate steps/solutions, and the intended use of the claimed components is also not given patentable weight. Therefore, the rejection over Brown remains.

Regarding Tennigkeit, Applicant again argues that the reference teaches dyeing hair, not wood. Where the claimed and prior art products are identical or substantially identical in composition, a prima facie case of either anticipation or obviousness has been established. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977). "Products of identical chemical composition cannot have mutually exclusive properties." If the prior art teaches the identical composition Applicant is claiming, the properties disclosed or claimed by Applicant are necessarily present. See *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Applicant has the burden of showing that the prior products differ from those as claimed. See MPEP 2112.01. Because no such evidence of record exists, the rejection over Tennigkeit remains as of record.

Regarding Light, Applicant again argues that Light treats leather rather than wood. This argument is not deemed persuasive for the reasons explained above. Applicant teaches that

Art Unit: 1751

Light's multiple steps teach away from the claimed invention. No methods are rejected over Light, and method steps cannot be read into the kit claim. For all these reasons, the above rejections remain.

Regarding Yantai, Applicant argues that the reference treats marble, not wood as claimed. This argument is not deemed persuasive for the reasons discussed above.

Regarding Bures, Applicant argues that the reference does not teach the claimed kits which comprise aqueous solutions being adapted to sequentially penetrate and react to form a color. Bures's first and third compositions read on the claimed kits which comprise first and second aqueous solutions. Bures's compositions are also applied sequentially, and result in a colored wood. Therefore, it is unclear which claim limitations Bures lacks, and the rejection therefore remains as of record.

Regarding the rejections over Dombay, Applicant argues that the references uses methylated spirits, which the present invention particularly avoids. The claims, which recite open claim language, never exclude methylated spirits from the claimed kits and methods. Although such additives may be undesirable, this does not necessarily exclude them from the claims.

Nothing on the record proves that the prior art's exemplified kits and methods differ from those as claimed. See MPEP 2112 for a discussion of the Office's treatment and interpretation of product (e.g. kit) and method claims. For all these reasons, the above rejections remain.

ART Unit: 1751

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. All official before final faxes should be sent to (703)305-7718. All official after final faxes should be sent to (703)305-3599. All non-official faxes should be sent to (703)305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.
January 27, 2000


CAROLINE D. LIOTT
PRIMARY EXAMINER